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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,540	01/16/2002	Gavriel J. Iddan	P-2752-US	1800

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT PAPER NUMBER

3736

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/046,540

Applicant(s)

IDDAN, GAVRIEL J.

Examiner

Jonathan ML Foreman

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The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 53-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-76 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/24/05 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 53, 58, 59, 61 – 63 and 65 – 71 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,993,378 to Lemelson.

In regards to claims 53, 58, 59, 61 – 63 and 65 – 71, Lemelson discloses a device (Figure 4) for determining an in vivo condition, having an interaction chamber (57); and an imager for capturing at least the interaction chamber (Col. 6, lines 38 – 47; Col 5, lines 40 – 42) ; wherein the interaction chamber and the imager are positioned behind an optical window (Col. 6, lines 3 – 10). A portion of the interaction chamber is transparent in the wavelength of an illumination provided by an illumination source. The device includes a lens (53). The imager is capable of capturing images

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of the body lumen (Col. 18, lines 3 – 30) . The device comprises a transmitter for transmitting image data and a receiving unit for receiving image data (Col. 1, lines 40 – 45). The distal end of the device forms a capsule shape. The device is capable of being inserted into the esophagus, i.e. swallowable. Lemelson discloses the device including a pump. Lemelson discloses the interaction chamber being a capillary (Col. 9, lines 25 – 28).

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 53 – 58, 60 – 63, 65, 66, 69 and 71 – 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/53792 A2 to Given Imaging Ltd. in view of U.S. Patent No. 6,330,464 to Colvin, Jr. et al.

In regards to claims 53 – 58, 60 – 63, 65, 66, 69 and 71 – 76, Given Imaging Ltd. Discloses an autonomous device capable of passing through a body lumen and determining in vivo conditions, the device having at least one interaction surface (54) for receiving a sample while in vivo, the surface having at least one color changing indicator immobilized thereon for reacting with the sample for generating optical changes (Page 6, lines 14 – 19); at least one illumination source (51) for illuminating the surface; and at least one optical detector (55) for detecting optical changes occurring on the surface. The surface is transparent in the wavelength of illumination (Page 11, line 30). Given Imaging Ltd. discloses the optical detector being an imager for obtaining images of the interaction surface and of the body lumen in which the device is disposed and producing video

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signals thereof (Page 11, line 29 – Page 12, line 3). The imager and interaction surface are considered to be positioned behind an optical window in that the optical window (53) extends to the left of both the interaction surface (52) and the imager (55) (Figures 7 and 8). The device includes a transmitter for transmitting the video signals and a receiving system for receiving the video signals (Page 11, line 26). Given Imaging Ltd. discloses the device being suitable for passing through a GI tract and receiving a sample from the GI environment (Page 11, line 32 – Page 12, line 2). Given Imaging Ltd. discloses the device being a swallowable capsule. However, Given Imaging Ltd fails to disclose the interaction surface being an interaction chamber or having a first and second interaction chamber including a first and second indicator respectively. Colvin, Jr. et al. discloses an autonomous device for determining in vivo condition. Colvin, Jr. et al. teaches the device having an indicator located within an interaction chamber. Each chamber is sealed by a membrane which selectively enables passage of a sample but not of the indicator (Col. 6, lines 51 – 56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the interaction surface as disclosed by Given Imaging Ltd. to include an interaction chamber as taught by Colvin, Jr. et al. in order to help protect the indicator while in use (Col. 25, lines 50 – 61). Additionally, Colvin, Jr. et al. discloses a first and second interaction chamber including a first and second indicator respectively (Col. 12, line 65 – Col. 13, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device as disclosed by Given Imaging Ltd. to include discloses a first and second interaction chamber including a first and second indicator respectively as taught by Colvin, Jr. in order to allow sampling of multiple constituents concurrently.

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6. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/53792 A2 to Given Imaging Ltd. in view of U.S. Patent No. 6,330,464 to Colvin, Jr. et al. as applied to claim 53 above, and further in view of U.S. Patent No. 6,498,941 to Jackson.

In regards to claim 64, Given Imaging Ltd. in view of Colvin, Jr. et al. disclose a device for determining in vivo conditions including an imager. Given Imaging Ltd. in view of Colvin, Jr. et al. disclose the imager being a CCD (Page 11, lines 22 – 28) but fails to disclose the imager being a CMOS. However, Jackson discloses a device for determining in vivo conditions wherein the imager can be a CCD or a CMOS (Col. 2, lines 54 – 59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the CCD as disclosed by Given Imaging Ltd. in view of Colvin, Jr. et al. with a CMOS as taught by Jackson in that Jackson teaches the CCD and CMOS as functional equivalents and therefore interchangeable.

### *Response to Arguments*

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*J*

JMLF

  
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